

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.:	07/ 978,891	Group Art Unit:	1644
Confirmation No.:	4493	Examiner:	R.B. Schwadron
Filed:	13 November 1992		
Applicant:	Darrell R. ANDERSON <i>et al.</i>		
For:	Therapeutic Application of Chimeric and Radiolabeled Antibodies to Human B Lymphocyte Restricted Differentiation Antigen for Treatment of B Cell Lymphoma		

Mail Stop **Petition**
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION UNDER 37 C.F.R. § 1.183

Sir:

Applicant is filing concurrently in this application a petition under 37 C.F.R. § 1.137(b) to revive the abandoned application on the basis of unintentional delay in filing a reply for the sole purpose of establishing copendency with a continuing application. Section 1.137(b)(4) requires, as one component of a petition under § 1.137(b), a terminal disclaimer pursuant to § 1.137(d).

Applicant petitions the Director to waive the requirement of § 1.137(b)(4) for the submission of a terminal disclaimer in connection with the concurrently-filed petition to revive, as discussed at M.P.E.P. § 711.03(c), subsection II.G.

Applicant requests that the Director debit that fee of **\$400** (§1.17(f)) from our **Deposit Account No. 18-1260**. Any other fee required for entry or consideration of this paper may be charged to the same account.

Facts

1. As explained in the concurrently-filed petition under § 1.137, application serial no. 07/978,891 may have become abandoned on 16 September 1993 for applicant's failure to file a timely reply to the nonfinal Office action mailed 15 June 1993.
2. Application serial no. 08/149,099 was filed on 3 November 1993 as a continuation-in-part of the '891 application. The '099 application matured to U.S. Patent No. 5,736,137 on 7 April 1998.
3. Several other applications and patents claiming priority under 35 U.S.C. § 120 to the '891 and '099 applications have been filed and prosecuted between 1993 and 2007, including U.S. Patent Nos. 5,736,137, 5,776,456, 5,843,439, 6,399,061, and 6,682,734, as well as pending application serial nos. 09/911,692, 09/911,703, and 10/238,681.

Discussion

Section 1.137(b)(4) requires that a patentee or applicant seeking to revive an abandoned application in certain circumstances must submit a terminal disclaimer as specified in § 1.137(d). Section 1.137(d)(1) provides that a petition to revive an application filed before 8 June 1995 should be accompanied by a terminal disclaimer for the lesser of the period of abandonment (*i.e.*, up to the date a petition to revive is granted) or the period beyond 20 years from the earliest claimed filing date.

Section 1.183 provides that the Director may waive any requirement of the regulations which is not a requirement of the statutes "[i]n an extraordinary situation, when justice requires." The provision of § 1.137(b)(4) is mandated solely by the rules and is not a requirement of the statute. Accordingly, the Directory has authority to waive this requirement pursuant to § 1.183.

The terminal disclaimer requirement of § 1.137(b) is discussed at M.P.E.P. § 711.03(c), subsection II.G. That section of the Manual states:

In the event that an applicant considers the requirement for a terminal disclaimer to be inappropriate under the circumstances of the application at issue, the applicant should file a petition under 37 CFR 1.183 (and petition fee) to request a waiver The grant of such a petition, however, is strictly limited to situations wherein applicant has made a showing of an "extraordinary situation" in which "justice requires" the requested relief. An example of such a situation is when the abandonment of the application caused no actual delay in prosecution

In this instance, the abandonment of the application did not lead to a delay in prosecution. The continuing application filed on 3 November 1993, serial no. 08/149,099, represents a complete reply to the outstanding Office action within the meaning of § 1.137. See M.P.E.P. § 711.03(c), subsection II.A. This application was filed within the period permitted by statute for reply to the outstanding Office action. Indeed, the '099 application had already been on file for more than a month when the examiner contacted applicant to inquire about the status of the '891 application. See interview summary dated 7 December 1993 (Paper No. 13). The '099 application was regularly processed and taken up for examination in turn, with no delay attributable to the period of abandonment in the parent application.

These facts suffice to demonstrate a showing of an extraordinary situation, where justice requires the requested relief, as set forth at M.P.E.P. § 711.03(c), subsection II.A. This is all the more so when the events in question occurred some 14 years ago, and applicant has since obtained patents with no reason to expect that the claim for priority to the original application under § 120 would not be effective.

* * *

Conclusion

Applicant respectfully requests that the Director waive the requirement of § 1.137(b)(4) for submission of a terminal disclaimer in connection with the concurrently-filed petition to revive application serial no. 07/978,891 for copendency with application serial no. 08/149,099.

Respectfully submitted,

/David L. Fitzgerald/

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